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REMARKSStatus of The Claims

The claims in this application are claims 1-22. Support for new claim 20 may be found, for example, in original claim 18. Support for new claim 21 may be found, for example, in original specification at paragraph [0031]. Support for new claim 22 may be found, for example, in Examples 1-2 of the original specification.

The claims have been subjected to an election of species requirement. The species represented by claims 3 and 14 were elected. The examiner has examined claims 1-6, 11-14 and 17-19. Claims 7-10, 15 and 16 have been withdrawn from further consideration at this time.

I. Claim Objection

The inadvertent omission from claim 5 pointed out by the examiner has been corrected.

II. Rejection under 35 USC § 112, First Paragraph

Claims 1-5, 11-14 and 17-19 have been rejected under the first paragraph of 35 U.S.C. 112 as lacking enablement in the specification as filed. This rejection and its accompanying remarks are respectfully traversed.

The examiner has made the rejection separately for the main and side chains. Since the issues are identical in both cases, applicants are treating them together. The examiner has stated that “[a] careful review indicates that the instant specification is not sufficient to support the generic concept” embodied by the instant claims. This rejection is erroneous.

First, no explanation of why that careful review supports this rejection has been presented.

Moreover, from paragraphs [0032] to [0070], the specification sets forth a large number of known low Tg (rubbery) monomers and high Tg (hard) monomers and various known methods of polymerizing them to yield the polymer compositions of the instant claims. If the examiner is challenging the person of ordinary skill's ability to produce the polymer compositions of the claims from that disclosure, she should so specify. The examiner has not satisfied the burden of suggesting why the various monomers and processes disclosed will not

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operate as asserted in the specification. The following is well established PTO procedure:

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of section 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. (emphasis added).

In re Marzocchi, 439 F.2d 220,223, 169 U.S.P.Q. 367, 369 (Fed. Cir. 1971).

The examiner apparently has made this rejection simply because the present claims are broad. It is an error to consider broad claims non-enabled simply because of their breadth. The question is whether or not the breadth of the claim is commensurate in scope with the enabling disclosure. To serve the constitutional purpose of promoting progress in the useful arts and provide effective incentives to inventors, broad claims should be allowed for broad inventions. *In re Goffe*, 542 F.2d 564, 191 U.S.P.Q. 429, 431 (Fed. Cir. 1976), *In re Sus*, 306 F.2d 494, 134 U.S.P.Q. 301,304 (Fed. Cir. 1962), *In re Skrivan*, 472 U.S.P.Q. 801, 166 U.S.P.Q. 85 (Fed. Cir. 1970).

For the foregoing reasons, it is respectfully requested that the rejection of claims 1-5, 11-14 and 17-19 for lack of enablement be withdrawn.

III. Rejection under 35 U.S.C. § 102(b)

Claims 1-6, 12 and 14 have been rejected under 35 U.S.C. 102(b) as being anticipated by Shah U.S. Patent No. 5,814,329. This rejection and its accompanying remarks are respectfully traversed.

The graft copolymers disclosed by Shah have a hydrophilic main chain and hydrophobic side chains. See column 4, lines 3-6. There is no disclosure in Shah of a rubbery phase and a hard phase as required by the present claims. Thus the very concept of the present invention is not disclosed. *Ex parte Rubin*, 5 U.S.P.Q. 2d, 1461 (BPAI 1987). On that basis alone, the reference fails as an anticipation.

To whatever extent the examiner considers that the reference accidentally discloses the here-claimed invention, i.e., that the present invention might be inherent in Shah, no case for inherency has been made out. As noted in MPEP 2112 this burden is on the examiner:

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The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).... "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted)...

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) ...

Furthermore, from the nature of the monomers disclosed in the reference it would appear to one of ordinary skill in the relevant art that both the hydrophilic main chain and hydrophobic side chain would correspond to hard phases, whereas neither chain would correspond to a rubbery phase. See, e.g., the present specification at paragraphs [0039] to [0045]. The examiner has presented no basis for a conclusion to the contrary.

For the foregoing reasons, it is respectfully requested that the rejection of claims 1-6, 12 and 14 for anticipation by Shah be withdrawn.

IV. Conclusion

In light of the foregoing remarks, applicants believe that all rejections of record have been obviated, and allowance of this application is respectfully requested. If the Examiner believes there are still unresolved issues, a telephone call to the undersigned at (703) 433-0510 would be welcomed.

The Office is authorized to charge any additional fees required to deposit account number 50-1047.

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Respectfully submitted,



David B. Bonham
Registration No. 34,297

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